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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/052,032	01/16/2002	Donald H. Lucast	56435US002	1581

32692 7590 02/08/2005

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EXAMINER

YAO, SAMCHUAN CUA

ART UNIT	PAPER NUMBER
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1733

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/052,032	LUCAST ET AL.	
	Examiner	Art Unit	
	Sam Chuan C. Yao	1733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) 16-24, 26, 34-43, 45-49 and 51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 25, 27-33, 44 and 50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 6-11, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al (US 2003/0032352 A1).

With respect to claims 1 and 15, Chang et al discloses a binder composition comprising a copolymerization product of a cationic monomer and at least one hydrophobic monomer, suitable cationic monomers are [2-(methacryloyloxy)ethyl]trialkyl ammonium halides such as a [2-(methacryloyloxy)ethyl]trimethyl ammonium chloride, etc., and suitable hydrophobic monomers are alkyl acrylates such as butyl acrylate, etc. (numbered paragraph 16 to numbered paragraph 22). Although not explicitly disclosed, hydrophobic monomers taught by Chang et al must inherently have a "*T_g of less than about 25°C*", when homopolymerized, because suitable hydrophobic monomers suggested by Chang et al are basically identical to the recited (meth)acrylate monomers disclosed in the present invention (numbered paragraphs 40-42; US 2003/0175503). Moreover, cationic monomers taught by

Art Unit: 1733

Chang et al must inherently have a "*Tg of at least about 25°C*", when homopolymerized, because suitable cationic monomers suggested by Chang et al are basically identical to the recited reinforcing monomer (numbered paragraphs 46-49; US 2003/0175503).

It is acknowledge that, Chang et al is silent on whether a resultant binder composition has a pressure sensitive adhesive (i.e. naturally tacky) characteristic. However, in view that, the binder composition taught by Chang et al is indistinguishable from the recited PSA composition, and in view that, Chang et al further teaches incorporating a detackifying agent to a binder composition to reduce a tack of the binder (numbered paragraph 112), thus suggesting that, the binder must inherently be tacky, the binder composition of Chang et al must inherently have a PSA characteristic.

With respect to claims 6-10, in light of the similarity of the compositions between a binder composition taught by Chang et al and a PSA composition in claim 1, the recited properties in these claims are expected to be inherent to the binder composition of Chang et al.

With respect to claim 11, see numbered paragraph 70, 99, and 123.

With respect to claim 25, a limitation of "*... adhesive polymer includes no more than about 5 weight percent of copolymerized acidic monomers ...*" reads on not using any copolymerized acidic monomers.

Note further: Where ... the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed

Art Unit: 1733

product. **Whether the rejection is based on "inherency" under 35 USC § 102, on prima facie obviousness" under 35 USC § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products."** In re Best, 562 F2d 1252, 1255, 195 USPQ 430, 433-4 (CCPA 1977).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-15,25,27-33,44 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al (US 2003/0032352 A1).

Note: a discussion of the Chang et al patent in numbered paragraph 2 is incorporated herein. Note further: the limitation in claim 1 is taken to be anticipated by the binder composition taught by Chang et al. The alternative rejection herein applies, in the event that, it can be shown that the binder composition taught by Chang et al does not inherently possess a PSA characteristic.

With respect to claims 1, and 25 it would have been obvious in the art to incorporate a tackifier to a binder composition, because Chang et al teaches, if desired, incorporating various agents such as a tackifier to a binder composition (numbered paragraph 70). It directly follows that, a resultant binder composition must naturally have a PSA characteristic. As noted in the preceeding paragraph,

Art Unit: 1733

a limitation of a limitation of "... *adhesive polymer includes no more than about 5 weight percent of copolymerized acidic monomers ...*" in claim 25 reads on not using any copolymerized acidic monomers.

With respect to claims 2-5, since it is old in the art to incorporate a poly(alkylene oxide) (meth)acrylic acid ester and a non-reactive poly(alkylene oxide) to a binder composition, these claims would have been obvious in the art.

With respect to claims 6-11 and 15, for the same reasons set forth above, these claims would have been obvious in the art.

With respect to claim 12, the recited amount of antimicrobial agent in a binder composition is old in the art. Moreover, one in the art would have determined a suitable amount of antimicrobial agent needed in formulating a binder composition suggested by Chang et al.

With respect to claims 13-14, the recited antimicrobial agents are notoriously well known in the art.

With respect to claims 27-33, 44 and 50, it is conventional in the art to apply a binder composition to a surface of a backing, claims 27 and 33 would have been obvious in the art. It is also well known in the art to use a naturally tacky binder for adhering a backing to a skin surface. Also see numbered paragraph 10 for various articles including "*medical care*" in which a binder composition of Chang et al are useful. For these reasons, these claims would have been obvious in the art.

Response to Counsel's Remarks

5. With respect to Counsel's request to consider withdrawn claims, as noted in a prior office action, **rejoinder of withdrawn claims will be considered upon indication of allowable subject matter.**

Brodnyan et al (US 4,356,229) is cited as a reference of interest. The chemical structure of a binder disclosed in this patent appears to be indistinguishable from the present PSA composition. The binder resin of Brodnyan et al includes an emulsion of a copolymer of ethylenically unsaturated monomers having: a) 1-8 wt% of a monoethylenically unsaturated carboxylic acid, b) 50-75 wt% C4-C8 alkyl acrylate, and c) 20-49 wt% of methyl methacrylate (col. 2 lines 3-16, lines 29-34), and further discloses that, "[t]he copolymer may be applied in free acid form ... or in the form of an alkali metal salt, ... an ammonium salt (-COONH₄) or a salt of a water-soluble amine, such as methylamine, diethylamine, triethylamine, ..." (emphasis added; col. 3 lines 18-26).

Conclusion


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sam Chuan C. Yao whose telephone number is (571) 272-1224. The examiner can normally be reached on Monday-Friday with second Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone

Art Unit: 1733

number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sam Chuan C. Yao
Primary Examiner
Art Unit 1733

Scy
02-07-05